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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/269,897 04/02/99 AOYAGI

K 4047

EXAMINER

HM12/0410

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ZEMAN, R	
ART UNIT	PAPER NUMBER

1645

11

DATE MAILED:

04/10/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/269,897

Applicant(s)
Aoyagi et al.

Examiner
Robert A. Zeman

Group Art Unit
1645



☒ Responsive to communication(s) filed on Feb 1, 2001

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 4 and 9-41 is/are pending in the application.

Of the above, claim(s) 12-30 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 4, 9-11, and 31-41 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 4 and 9-41 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1645

DETAILED ACTION

The amendment filed on 2-1-2001 is acknowledged. Claims 4 and 9-11 have been amended. Claims 1-3 and 5-8 have been canceled. Claims 31-41 have been added. Claims 4, 9-11 and 31-41 are pending and currently under examination.

Claim Objections Maintained

The objection to claims 4-6 and 7-11 for failing to introduce each claim with the proper article is maintained for reasons of record. Said objection was not addressed by Applicant the amendment filed 2-1-2001.

New Claim Rejections

35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Regarding claims 10, 36 and 40, the phrases "i.e. and e.g." render the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Art Unit: 1645

Claim Rejection Withdrawn

35 USC § 112

The rejection of claims 1-3 under 35 USC § 112, second paragraph, being vague and indefinite for failing to recite proper active method steps is withdrawn. Cancellation of said claims has rendered the rejection moot.

The rejection of claims 1 and 2 under 35 USC § 112, second paragraph, for reciting improper Markush language is withdrawn. Cancellation of said claims has rendered the rejection moot.

The rejection of claim 10 under 35 USC § 112, second paragraph, for reciting improper Markush language is withdrawn in light of the amendment thereto

Claim Rejection Maintained

35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The rejection of claims 31 and 9-10 under 35 USC § 102 is maintained for reasons of record in rejecting claims 1 and 8-10 in the previous office action.

Art Unit: 1645

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that features upon which applicant relies (i.e., the concentration of the anionic surfactant and non-ionic surfactant) are not recited in the rejected claim(s).

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 1645

The rejection of claims 4, 9-11 and 31-41 under 35 U.S.C. 103(a) as being unpatentable over Sharma (WO 92/19285) in view of Kokai (Japanese Patent Abstract No. 53-104724, IDS-4) and Cloyd et al. (U.S. Patent No. 6,074,646) is maintained for reason of record in rejecting claims 1-10 previously.

Applicant argues:

1. Sharma is directed to the disinfection of blood products which is different than that of the present invention.
2. Sharma does not refer to all the advantages of the instant invention.
3. Croyd et al. and Kokai disclose the same components as the instant invention, but since the purpose of Sharma differs from that of the instant invention the instant invention cannot be realized.
4. There is no motivation to combine the references.

Applicant's arguments have been fully considered and have been deemed non-persuasive.

As outline previously in Paper No.9, Sharma discloses a composition and method of use for disinfecting blood and discloses that the method is useful for preparation of samples for laboratory testing. Said composition contains at least one non-ionic surfactant and a stabilizer. Sharma differs from the claimed invention in that he does not disclose the use of combination of surfactants (i.e. non-ionic, anionic and amphoteric). Kokai No. 53-104724 discloses the use of non-ionic surfactants and protein-denaturing agents (urea) for the removal of HBV antigens from blood samples (See 2nd paragraph). Cloyd et al. disclose the treating of HIV infected sera with a variety

Art Unit: 1645

of amphoteric surfactants, non-ionic surfactants, anionic surfactants and protein denaturing agents (See column 19). Additionally Cloyd et al. disclose that the aforementioned agents inactivated the viral agents in the sample since they were non-reactive to HIV specific antibodies. Consequently, it would have been obvious to one of skill in the art to use the combinations of surfactants disclosed by Cloyd et al. and Kokai No. 53-104724 in the method disclosed by Sharma since the **combinations** of the various surfactants and protein denaturing agents would enhance the effectiveness of the Sharma's method of disinfecting samples for use in laboratory tests since their effects would be additive. Additionally, Kokai No 53-104727 disclose that the use of the disclosed reagents results a material that can be used as raw material for a vaccine and a standard antigen reagent. Consequently, all the limitations of the instant invention are encompassed by the combination of the cited references. Applicant is reminded that the aforementioned rejection is based on the combination of **all** the cited references.

Art Unit: 1645

35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The rejection of claim 4 under 35 USC § 112, second paragraph, being vague and indefinite for use of the phrase "contains urea, an imidazole ring-containing compound or and indole ring-containing compound" is maintained for reasons of record. Applicant has failed to address said rejection in his response.

Conclusion

No claim is allowed.

This application contains claims 13-30 drawn to an invention nonelected with traverse in Paper No. 8. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

Art Unit: 1645

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert A. Zeman whose telephone number is (703) 308-7991. The examiner can be reached between the hours of 7:30 am and 4:00 pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, Donna Wortman, Primary Examiner can be reached at (703) 308-1032 or the examiner's supervisor, Lynette Smith, can be reached at (703)308-3909.


DONNA WORTMAN
PRIMARY EXAMINER

Robert A. Zeman

April 6, 2001